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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,856	11/01/2001	Quynh T. Pham	J6655(C)	9814

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UNILEVER
PATENT DEPARTMENT
45 RIVER ROAD
EDGEWATER, NJ 07020

EXAMINER

FUBARA, BLESSING M

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 11/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/044,856

Applicant(s)

PHAM ET AL.

Examiner

Blessing M. Fubara

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Examiner acknowledges receipt of supplemental IDS filed 05/14/03 and amendment A filed 05/08/03.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 9-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 9 recites the limitation "further comprises an elastomer." However, claim 8 is a composition that consists essentially of polyhydric alcohol humectant, polymeric wetting agent and a cosmetically acceptable vehicle. The consisting essentially of language does not permit further ingredients such as an elastomer that would affect the novel characteristic of the composition of claim 8 by affecting the flexibility or elastomeric character of the composition.

4. Claim 10 recites the limitation "further comprises a volatile silicone." However, claim 8 is a composition that consists essentially of polyhydric alcohol humectant, polymeric wetting agent and a cosmetically acceptable vehicle. The consisting essentially of language does not permit further ingredients such as a volatile silicone that would affect the novel characteristic of the composition of claim 8 by affecting the lubricant character of the composition. Volatile silicone is a lubricant.

5. Claim 11 recites the limitation "further comprises a fluid oil." However, claim 8 is a composition that consists essentially of polyhydric alcohol humectant, polymeric wetting agent

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and a cosmetically acceptable vehicle. The consisting essentially of language does not permit further ingredients such as a fluid oil that would affect the novel characteristic of the composition of claim 8 by affecting the lubricant character of the composition. Fluid oil is a lubricant.

6. Claim 12 recites the limitation "further comprises a crystalline fatty acid." However, claim 8 is a composition that consists essentially of polyhydric alcohol humectant, polymeric wetting agent and a cosmetically acceptable vehicle. The consisting essentially of language does not permit further ingredients such as crystalline fatty acid that would affect the novel characteristic of the composition of claim 8 by acting as a plasticizer. Crystalline fatty acid is a plasticizer.

It is however noted that Brewster lists siloxanes and silicones as cosmetically acceptable vehicles, and further comprising is excluded by the consisting essentially of language in claim 8.

Specification

Examiner wishes to thank applicants for capitalizing the trademark names in the specification.

Claim Rejections - 35 USC § 102

7. Claims 1, 3, 5 and 7 remain rejected under 35 U.S.C. 102(b) as being anticipated by Brewster et al. (US 5,128,123).

Applicants require the examiner to specifically establish that the "descriptive matter missing from the reference is necessarily present in the reference's disclosure" and applicants cited the Continental Can Company, U.S.A. v. Monsanto Company (Fed. Cir. 1991). Furthermore, applicants argue that the prior art does not teach a wetting agent

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that forms a uniform film in a wetting test and as such there can be no inherency except disclosed in Brewster.

Response to Arguments

8. Applicants' arguments filed 05/08/03 have been fully considered but they are not persuasive.

The descriptive matter missing from the reference does not necessarily have to be disclosed in the reference. In this instance, the non-sticky nature of the composition is what is at issue. Examiner respectfully presents that a composition comprising about 10% to about 90% polyhydric alcohol and about 0.1% to about 10% polymeric wetting agent and a cosmetically acceptable vehicle would inherently be non-sticky, which is a property of the composition. Secondly, applicants have no showing as to why a composition that contains about 10% to about 90% polyhydric alcohol and about 0.1% to about 10% polymeric wetting agent and a cosmetically acceptable vehicle would not be non-sticky. Thirdly, the state of non-sticky or sticky is a question of degree, which applicants have not defined.

Regarding the Monsanto case, the circumstance in the Monsanto case cited by applicants is clearly different from that in the present situation. In the Monsanto decision, the features were hollow ribs versus non-hollow ribs. In the present case, the claim broadly claims non-sticky and the degree of stickiness or lack thereof is not defined. "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." See *in re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990); *in re Best*, 562 F.2d at 1255, 195 USPQD at 433; *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).

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Claim Rejections - 35 USC § 103

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 4 and 6 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Brewster et al. (US 5,128,123).

Applicants argue that a disclosure of isopropyl palmitate does not suggest silicone oils and that claim 1 is non-obvious over Brewster.

Response to Arguments

11. Applicants' arguments filed 05/08/03 have been fully considered but they are not persuasive.

Brewster teaches cyclomethicone and dimethicone and cyclomethicone and dimethicone are volatile silicon oils and Brewster anticipates claim 1.

12. Claims 1-7 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Beerse et al. (US 6,294,186).

Applicants argue that the amount of polyhydric alcohol in Beerse is lower than the recited amount and thus claims 1-7 cannot be obvious over Beerse.

Response to Arguments

13. Applicants' arguments filed 05/08/03 have been fully considered but they are not persuasive.

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Beerse specifically and clearly teaches 28% polyhydric alcohol in examples 16-18.

Silicones or siloxanes are disclosed in applicants' specification, page 9, lines 21-28, as cosmetically acceptable vehicles.

14. Claims 8 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spellman et al. (US 5,063,057).

Spellman discloses a cosmetic composition (column 3, lines 60) comprising polydimethyl phenyl siloxane cosmetically acceptable vehicle (column 4, line 4), 0.5-30% surfactant (column 4, lines 15-22) and 0.5-50% propylene glycol or sorbitol or glycerin (column 4, lines 65 and 66). Page 9, lines 21-28 of applicants' specification disclose silicones or siloxanes as cosmetically acceptable vehicle. Surfactants are amphipathic molecules, thus meeting the limitation of wetting polymers. Sorbitol and glycerin are polyhydric alcohols.

Spellman discloses the instant cosmetic composition except that the amount of the polyhydric alcohol in the prior art is about 0.5% to 50% while in the instant claim it is about 0.15 to 10%. Non-sticky is a question of degree, which is not defined/described. Regarding the percent amount of the polyhydric alcohol, when the general conditions of a claim are taught in the prior art, it is not inventive to come up with workable ranges. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare the cosmetic composition of Spellman. One having ordinary skill in the art would have been motivated to use an amount of polyhydric alcohol emollient with the expectation of providing a composition that has the desired moisturizing property.

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15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is 703-308-8374. The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 703-308-2927. The fax phone number for the organization where this application or proceeding is assigned is 703-305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Blessing Fubara
Patent Examiner
Tech. Center 1600


THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
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